AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes new Figs. 7a-7d. Support for the addition of Figs. 7a-7d can be found in Figs. 2a-2d of International Publication No. WO 01/26032 (PCT/SE00/01895), which was incorporated by reference in the original specification. Accordingly, the addition of Figs. 7a-7d does not include new matter.

Attachment: New Sheet of Drawings – Figs. 7a-7d

REMARKS

Claims 1-39 are currently pending, wherein claims 1, 9, 11-13, 15, 16, 22, 23, 28, 29, 31, and 35-39 have been amended to even more clearly define the present invention. Applicant respectfully requests favorable reconsideration in view of the remarks presented herein below.

In paragraph 8 of the Office Action ("Action"), the Examiner rejects claims 1-39 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, the Examiner asserts that the terms "marks" and "grid points" are not mentioned in the specification.

Applicant hereby amends the specification to incorporate the appropriate subject matter from International Publication No. WO 01/26032 (PCT/SE00/01895), which was incorporated by reference in the specification as originally filed. Support for the amendments to the specification can be found, for example, at page 4, lines 9-16, page 5, lines 29-33, page 6, lines 22-30, page 11, lines 19-36, and page 29, lines 6-9 of International Publication No. WO 01/26032. Accordingly, the above-identified amendments to the specification do not introduce new matter. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-39 under 35 U.S.C. § 112, first paragraph.

In paragraph 10 of the Action, the Examiner rejects claims 11, 12, 15, and 22 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. More specifically, the Examiner asserts that these claims are improper hybrid claims because they define an apparatus, yet depend from a method. Applicant hereby amends claims 11, 12, 15, and 22 to address the Examiner's concerns. Accordingly, Applicant

respectfully requests reconsideration and withdrawal of the rejection of claims 11, 12, 15, and 22 under 35 U.S.C. § 112, second paragraph.

In paragraph 12 of the Action, the Examiner rejects claims 1-39 under 35 U.S.C. § 112, second paragraph, because there is allegedly insufficient antecedent basis for the phrase "grid points." Applicant hereby amends independent claims 1, 9, 13, 16, and 23 to remove the phrase "grid points," thereby rendering this rejection moot.

In paragraph 14 of the Action, the Examiner rejects claims 11, 12, 15, and 22 under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. More specifically, the Examiner asserts that these claims "embrace and overlap two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set forth the statutory classes of invention in the alternative only." Applicant hereby amends claims 11, 12, 15, and 22 to clearly recite a single class of statutory subject matter, thereby rendering this rejection moot.

In paragraph 16 of the Action, the Examiner rejects claims 1-39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,629,499 to Flickinger et al. ("Flickinger") in view of U.S. Patent No. 5,477,012 to Sekendur ("Sekendur"). Applicant respectfully traverses this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-39 are not rendered unpatentable by the combination of

Flickinger and Sekendur for at least the reason that the combination fails to disclose each and every claimed element. More specifically, Applicant maintains that neither Sekendur nor Flickinger, independently or in combination, teach or suggest, at least, "a position coding pattern ... wherein each position is encoded by directions of displacements between a plurality of marks and raster points," as recited in claim 1; "a position-coding pattern ... wherein the position coding pattern utilizes directions of displacements between a plurality of marks and raster points," as recited in claims 9, 13, and 16; and "wherein the preprinted coding information utilizes the directions of displacements between a plurality of marks and raster points to code different symbol values," as recited in claim 23.

As correctly noted by the Examiner, Flickinger fails to disclose an optically detectable position coding pattern of any kind, much less one as defined by independent claims 1, 9, 13, 16, and 23. Accordingly, the Examiner relies on the teachings of Sekendur to overcome the deficiencies of Flickinger. More specifically, the Examiner asserts that Sekendur discloses a position coding pattern wherein each position is encoded by directions of displacements between a plurality of marks and raster points inasmuch as Sekendur discloses a position coding pattern.

Although Sekendur discloses a position coding pattern, nowhere in Sekendur is there any disclosure or suggestion that positions are encoded by *directions of displacements between a plurality of marks and raster points* as claimed. To the contrary, in all of the embodiments of Sekendur, information is encoded by the presence and absence of marks in predetermined locations.

In one embodiment, Sekendur discloses a surface systematically encoded with a plurality of dots. Each dot, as shown in Figure 1, is divided into three concentric circles partitioned into quadrants. The center circle forms a small dot, while the other circles form inner and outer concentric rings. Each quadrant of each ring represents a digit of a 4-digit number and is further divided into four equal slices, the upper right quadrant of the first digit moving clockwise. The outer ring represents the X-coordinate and the inner ring represents the Y-coordinate. As shown in Fig. 2, values are encoded by the presence and absence of marks at predetermined locations within each dot. (See col. 4, lines 28-41.) For example, a value of "0" is encoded by having no markings in the dot, and a "blank" value is encoded by marking all of the space within the dot save the center portion. By alternating the presence and absence of markings within each dot, position values may be encoded. Moreover, while the plurality of dots are arranged in a systematic manner, this embodiment does not disclose raster points or that position is determined based on the displacement of a mark from the raster point as claimed.

Sekendur discloses other distinct embodiments showing alternative ways of encoding position information, including a barcode system and a system of checkerboard-like squares. (See col. 4, lines 46-48; Figs. 4 and 5, respectively.) Note that in Fig. 5a, one portion of the checkerboard is delineated to the X coordinate while the other portion of the checkerboard is delineated to the Y coordinate. From Fig. 5a, it can be seen that the encoding is performed by the presence and absence of a sub-square within the checkerboard; whereby different values are determined based upon the location of the sub-square within the square array shown in 5a. A plurality of square arrays comprises the checkerboard as shown in Fig. 5. However, nowhere in these

alternative embodiments, like the first, is there any disclosure or suggestion of coding positions based on the *direction* of displacements between a plurality of marks and raster points as claimed.

Since Flickinger and Sekendur both fail to disclose or suggestion a position-coding pattern wherein each position is encoded by directions of displacements between a plurality of marks and raster points as claimed, the combination of these two references cannot possibly disclose or suggest said elements. Therefore, even if one skilled in the art were motivated to combine Flickinger and Sekendur, which Applicant does not concede, the combination would still fail to render claims 1-39 unpatentable because the combination fails to disclose each and every claimed element.

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle (Reg. No. 46,607) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

Penny Caudle

By Penny Caudle Reg # 46,607
Michael K. Mutter
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: New Sheet of Drawings – Figs. 7a-7d